III.   REMARKS

Status of the Claims

Claims 1, 7, 14, and 15 are amended. Claims 1-15 are presented for further consideration.

Summary of the Office Action

Claims 1-15 stand rejected under 35USC103(a) based on the reference Rivette, U.S. Patent No.5,623,679 in view of the reference Warnock, et al, U.S. Patent No. 5,634,064.   The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

Applicant has amended the claims of this application to further support the distinguishing features argued in the prior response.

The rejection is traversed for the following reason:

The disclosure of the reference Rivette in view of the disclosure of Warnock does not render claims 1-15 obvious because the combined teachings fail to teach or otherwise suggest each and every limitation of the claims. It is well established that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.   *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970).

In particular claim 1, as amended, states:

"- **storing language specific rules of syntax in a memory;**
- processing the text, based on the stored language specific rules of syntax, to identify a start element and end element,

- selecting the text portion between the start element and end element as the reading portion and placing the selected portion on the read pane, and

- further processing the text for a new start element and a new end element and selecting the text portion between the new start element and new end element as the reading portion and placing the selected portion on the read pane, if a shift command is received."

Amended claims 7, 14, and 15 contain equivalent language. The cited references Rivette and Warnock, considered either alone or in combination, fail to disclose or suggest these claim elements.

The substance of the disclosure of Rivette is described concisely in the abstract, as follows:

"The graphic user interface of the present invention permits the user to display, manipulate, and edit the Equivalent File created using the process of the present invention, and to simultaneously view the image file on the display."

According to the claims as amended, the system of the subject application is directed to a solution for the problem of viewing large HTML files on a small screen. It provides a means by which a full page of text can be viewed on a navigation pane of the display, while readable portions of the text is displayed on a read pane. The readable portions are defined by start elements and end elements selected based on language specific rules of syntax. This is clearly described in amended independent claims 1,7,14, and 15. The cited references, therefore, fail to disclose each and every claim limitation.

The Examiner in the response to Applicant's arguments indicates that the prior claims:

"fail to describe who is searching the text, how the text is being search, i.e. processor, user, what defines language specific rules".

The claims, as amended, recite that a processor defines reading portions selected by identifying start elements and end elements, based on language specific rules of syntax stored in memory. The reading portions are displayed on the read pane in succession as prompted by a shift command. Applicant submits that these limitations are fully defined and understandable by a person skilled in the art and even in their broadest ***reasonable*** interpretation do not include:

"the search of a reference beginning with a title (start element) and ending with a period (end element)."

It is well known that the syntax of a language refers to the grammatical structure of a language including the arrangement of words to show relationships of meaning within a sentence. There is no basis in the cited references for selecting a portion of a page of text, based on syntax, for display in order to permit it to be readable on a small screen.

These claim limitations therefore cannot be ignored.

The Examiner has failed to consider the claims as a whole and Applicant reiterates its prior comments with respect to this issue and the many other distinguishing features of the system of this application.

It is well settled that in order to establish a prima facie case for obviousness, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application.

The reference Rivette does not teach dividing the display into a navigation pane and a read pane, nor does it mention anything about searching for start elements and end elements based on language specific rules of syntax. Warnock

does not remedy these deficiencies. Applicant submits that the modification of the teachings of Rivette and Warnock in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art. Also, there is no indication that such a modification would be desirable.

Again, it does not appear that the Examiner has considered the claims as a whole but has dismantled the claims and pursued a search for the individual features. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:
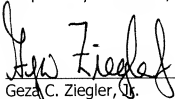
"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

The above arguments apply equally to the rejected dependent claims.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

_____   29 Nov 2006
Geza C. Ziegler, Jr.   Date
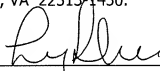Reg. No. 44,004

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